## REMARKS

The office action mailed 29 October 2007 has been received and reviewed. Claims 1-16 were rejected under 35 USC 101 for being directed to non-statutory subject matter. Claims 4-6 and 19 were rejected under 35 USC 112 for failing to point out and distinctly claim the subject matter which the Applicants regard as the invention. Claims 1-23 were rejected under 35 USC 102(e) as being anticipated by Ring, et al., U.S. Patent No. 7,090,104 [hereinafter "Ring"].

Regarding the rejections under 35 USC 112, Applicants have amended claims 4-6 to incorporate the amendments recommended by the Examiner. Applicants thank the Examiner for noticing the errors and providing the recommended amendments.

Regarding the rejection of claims 1-16 under 35 USC 101 and the assertion that the claimed invention is directed to non-statutory subject matter, Applicants refer the examiner to paragraphs 20-22 and the description of modules. For example, paragraph 20 states:

> ... a module may be implemented as a hardware circuit comprising custom VLSI circuits or gate arrays, off-the-shelf semiconductors such as logic chips, transistors, or other discrete components. A module may also be implemented in programmable hardware devices such as field programmable gate arrays, programmable array logic, programmable logic devices or the like.

Applicants note that the definition of the term module included in the application encompasses both hardware, software embodiments, or a combination of both. For example, Applicants assert that the present invention could be embodied as a portable device such as a messaging enabled cell phone using programmable logic devices or an application specific integrated circuit ("ASIC") containing hardware and software. Furthermore, Applicants assert that the use of

programmable logic devices may be a preferred embodiment in some instances. See for example http://www.impulsec.com and http://www.xilinx.com/ise/embedded_design_prod/index.htm.

Given the foregoing, Applicants assert that is reasonable to interpret modules as either hardware or software and that the rejection under 35 USC 101 is unnecessary. However, to further prosecution, the Applicants have elected to amend claim 1 to traverse the rejection. Specifically, Applicants have amended claim 1 to include the clause "wherein the retrieval module, validation module and the insertion module comprise at least one of logic hardware elements and executable code, the executable code stored on one or more computer readable media." This amendment clearly states that a module can be hardware, software, or both and is fully supported in the specification, for example see paragraphs 20-22, and in the claims. Note that an interpretation where Claim 1 is deemed solely software is statutory under the amendment because where the executable code is software is claimed to be stored on one or more computer readable media. Note that claim 20 recites "a computer readable medium."

A brief review of the present invention may clarify the novelty of Applicants' claims over the cited prior art. The present invention compiles a messaging contact list from a plurality of sources such as address books on local client computer. In some embodiments, a user is prompted to resolve conflicts in the contact information and accept or reject the contact information for particular users (see, for example, paragraphs 8, 31, and 35). The present invention thereby provides a user with significant control over the compilation process particularly when combining contact information from multiple lists.

The prior art in contrast is directed to an automated server side automated process. For example, in lines 27-32 of column 3, Ring discloses "synchroniz[ing] data... with nominal or no

need for user intervention" as well as "merg[ing] data… with nominal or no need for user intervention." By teaching away from user selectivity, Ring teaches away from the claimed invention of the Applicants. For example, in column 10 lines 4-19, Ring discloses a DBMS that recalls data from a server. As indicated by 144 and 114 of figure 1, the DBMS resides on the server and retrieves contact information from a server side database. Ring also discloses methods consistent with e-mail communication protocols to extrapolate information about external users in column 19 lines 61-67.

The present invention, on the other hand, collects data from multiple local sources on a user's computer such as address books with various storage formats. As explained in paragraph 34 of Applicants' specification, "the contact sources may be electronic address books stored locally …."

Regarding the rejection of each of the independent claims, Applicants have amended each of the independent claims to indicate that sources of contact information are local to the client computer. Furthermore, Applicants have added limitations to indicate that the user may be prompted to accept or reject the contact information. For example, claim 8 has been amended to include "prompting the user to accept or reject the contact information for each online user." Similar amendments have been made to each of the other independent claims. Applicants assert that the amendments distinguish the present invention from the cited prior art and are supported in the specification.

For the foregoing reasons, Applicants submit that each of the claims is in condition for allowance. In the event any questions remain, the Examiner is respectfully requested to contact the undersigned by phone.

Respectfully submitted,


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